

REMARKS

In the Final Office Action,¹ the Examiner:

- (1) objected to the specification;
- (2) rejected claims 25 and 27-36 under 35 U.S.C. § 101;
- (3) rejected claims 1, 3-5, 7-13, 19, 20, 25, 27-31, and 33-38 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,721,906 (*Siefert*) in view of U.S. Patent No. 6,820,082 (*Cook*), U.S. Patent Application Publication No. 2003/0130994 (*Singh*), and U.S. Patent Application Publication No. 2003/0046401 to Abbott (*Abbott*);
- (4) rejected claims 6, 14-16, 18, and 32 under 35 U.S.C. § 103(a) over *Siefert* in view of *Cook*, *Singh*, *Abbott* and U.S. Patent Application Publication No. 2005/0086204 (*Coiera*); and
- (5) rejected claim 17 under 35 U.S.C. § 103(a) over *Siefert* in view of *Cook*, *Singh*, *Coiera*, *Abbott* and U.S. Patent No. 6,636,837 (*Nardozzi*).

By this Amendment, claims 1 and 25 are amended, and claims 4, 21-24, 28 and 38 are canceled without prejudice or disclaimer. Thus, claims 1, 3, 5-20, 27, and 29-37 are pending in this Application.

1. Objection to the Specification

The Final Office Action objects to the specification as allegedly failing to provide proper antecedent basis for “machine-readable storage medium.” See Final Office Action, pg. 3. Without conceding the propriety of the Office Action’s characterization of

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

the specification, paragraph [0063] is amended to recite a “machine-readable storage medium.” Accordingly, Applicant respectfully requests withdrawal of the objection.

2. Rejections Under 35 U.S.C. § 101

The Office Action rejects claims 25 and 27-36 under 35 U.S.C. § 101 for allegedly not being directed to statutory subject matter because the phrase “machine-readable storage medium” is allegedly not defined in the specification. See Final Office Action, pgs. 3-5. As discussed above, the specification is amended to recite “machine-readable storage medium.” Such an amendment is supported throughout the specification at, for example, paragraph [0009] that recites “a machine-readable medium storing machine-readable instructions.” Thus, for at least these reasons, Applicant respectfully requests withdrawal of the rejection of claims 25, 27, and 29-36 under 35 U.S.C. § 101. Claim 28 is canceled, rendering its rejection moot.

3. Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of claims 1, 3-20, 25, and 27-38 under 35 U.S.C. § 103(a) over combinations of *Siefert, Cook, Singh, Abbott, Coiera, and Nardozzi*. Claims 1 and 25 are amended to incorporate the subject matter of dependent claims 4, 28, and 38, and claims 4, 28, and 38 are canceled rendering their rejection moot. Accordingly, the rejection of claims 4, 28, and 38 will be discussed as if applied to claims 1 and 25.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.”

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation

omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites, in part, “storing the hit-list as a collection of resources that is used for further actions or stored as a persistent collection, the stored hit-list including a collection of heterogeneous resources.” Claim 25, although of different scope, recites a similar element.

The Office Action alleges that *Siefert* discloses this element because “*Siefert* discloses different types of resource profiles . . . [such] as books, movies, and documents” and that the user is provided with a retrieved hit-list which can be “used for [the] further action of retrieving implying that the hit-list of resources are stored before

the retrieving.” See Final Office Action, pg. 15. However, these allegations are incorrect.

Siefert discloses a system for managing resources, such as books. See col. 4, line 65-col. 5 line 7. Each resource is associated with a profile, and the user can search through the profile based on a particular search criteria and obtain a results list. See Fig. 11; see also col. 5, lines 30-57 and col. 10, lines 43-62. If the user wishes to obtain the resource from the list, the user highlights the item from the results list and actuates a “RETRIEVE” button. See col. 5, lines 30-57. Thus, *Siefert* does not disclose “storing the hit-list as a collection of resources that is used for further actions or stored as a persistent collection, the stored hit-list including a collection of heterogeneous resources” as recited in claim 1 and similarly recited in claim 25. Instead, *Siefert* discloses storing all of the resources (irregardless of a subsequent results list) and using the results list as an access point to download the selected resource.

Singh, Cook, Abbott, Coiera and Nardozzi fail to remedy the deficiencies of *Siefert*, as *Singh, Cook, Coiera and Nardozzi*, alone or in combination, fail to teach or suggest at least “storing the hit-list as a collection of resources that is used for further actions or stored as a persistent collection, the stored hit-list including a collection of heterogeneous resources,” as recited in claim 1, and similarly recited in claim 25.

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Final Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary

skill in view of the prior art. Therefore a *prima facie* case of obviousness has not been established for independent claims 1 and 25.

Furthermore, the Final Office Action has failed to establish a *prima facie* case of obviousness for the claims that depend from independent claims 1 and 25 at least based on their dependence on allowable base claims, as well as for additional elements they recite. For example, claim 37 recites, in part, “wherein the narrowed hit-list is displayed based on the resource type.” The Final Office Action alleges that this element is taught by Figs. 8-9 and paragraphs [0079], [0163], and [0204] of *Singh*, and that resource types include books, movies, documents, and the like. See Final Office Action, pg. 15. However, these allegations are incorrect.

The portions of *Singh* cited in the Final Office Action are directed to *Singh*’s ability to narrow the search based upon ISBN number, search words, publisher, subject, authors, or title. These disclosures do not teach or suggest displaying a narrowed hit-list based on the resource type at least because they are not directed to narrowing based on the Examiner’s alleged “resource types” (i.e., books, movies, and documents).² Accordingly, the Final Office Action has failed to establish a *prima facie* case of obviousness for claims 3, 5-20, and 27-37 at least due to their dependence from independent claims 1 or 25, as well as for the additional elements they recite.

5. Conclusion

In view of the foregoing, Applicant requests the Examiner’s reconsideration and reexamination of the application, and the timely allowance of the pending claims.

² Applicant does not concede that the Final Office Action’s characterization of resource type is correct.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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